

REMARKS

The examiner has repeated the rejection of the claims as set forth in the office action of November 14, 2003 (claims 45-48, 52-27, 59, and 60 as obvious over Waterman in view of GB '862, and claims 52 and 58 as obvious over Brorrein in view of GB '862). In Response to Arguments, the Examiner states:

Applicant's arguments filed May 10th 2004 have been fully considered but they are not persuasive.

In response to applicant's argument that why one of ordinary skill in the art would want to "provide a distinguishing mark on the cable", it is very well-known in the art that providing a distinguishing mark on a cable is for the identification purpose. It is not necessary for the Office Action to further state that providing a distinguishing mark on the cable is "for the identification purpose".

In response to applicant's argument that there is no suggestion to combine the Waterman and GB'862 references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the motivation to do so is found in the references themselves. Specifically, GB'862 does teach providing a coating having a difference appearance from the outer surface of a conductive sheath to provide a distinguishing marker on the sheath.

In response to applicant's arguments that GB'862 teaches placing marker on each individual conductor and not on the outer surface of a cable, the test for obviousness is not whether the features of a secondary reference may be bodily incorporate into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642, F.2d 413, 208 USPQ 871 (CCPA 1981).

Contrary to the Examiner's assertion, the teachings of GB '862 do not provide any motivation to combine or modify the teachings of the references to produce the claimed invention. Furthermore, the combined teachings of the references would not have suggested to those of ordinary skill in the art the modification to the primary references proposed by the

Examiner. As discussed in the response dated May 10, 2004, one skilled in the art, presented with GB '862 and Waterman, simply would not have been led to place markers on the outer surface of Waterman's tube, as this is not what is described by GB '862. Rather, if one were to apply the conductors and conductor markers of GB '862 to Waterman's tube, the combination would result in conductors 1, each with its associated surrounding materials 2-6, being located within Waterman's tube. Thus, each conductor within the tube, not the outer surface of the tube, would individually include a marker.

One skilled in the art, presented with GB '862 and Brorein, would not have been led to place markers on the outer surface of Brorein's cable, i.e., on metallic sheath 18, as this is not what is described by GB '862. Rather, if one were to apply the method of marking of GB '862 to Brorein's cable, the combination would result in marking the non-conductive insulation surrounding each individual conductor 30 located within Brorein's cable, not the outer surface of the cable.

That GB '862 describes a distinguishing marker (5) on a conductive screen helix (4) does not provide the required motivation for combining the references as proposed by the Examiner. It is mere hindsight reconstruction, using the applicant's claims as a template, that the Examiner is employing in modifying the primary references.

Applicant : Falciglia et al.
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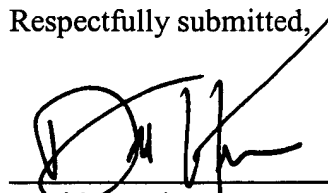
Attorney's Docket No.: 01082-010006 / 35256:E

All claims are in condition for allowance. Please apply any charges or credits to deposit account 06-1050, referencing 01082-010006.

Respectfully submitted,

Date: _____

10/8/11



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